

REMARKS

I. Introduction

Applicants add new claims 31-37. Therefore, by this Amendment, claims 1-37 are all the claims pending in the application, and claims 1-30 were examined. The Examiner rejects claims 1-4, 6, 8-19, 22-27, and 30 under 35 U.S.C. § 102(e) as allegedly being anticipated by Quinn, U.S. Patent No. 5,944,786 (hereinafter "Quinn"). Additionally, the Examiner rejects claims 5, 7, 20-21, and 28-29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Quinn in view of Shaffer et al., U.S. Patent No. 6,094,681 (hereinafter "Shaffer"). Applicants cancel claim 30 and traverse the rejection of claims 1-29 as follows.

II. Claim Rejections -- 35 U.S.C. § 102(e)

Claims 1-4, 6, 8-19, 22-27, and 30 stand rejected under § 102(e) as allegedly being anticipated by Quinn.

A. Claims 1 and 16

Claims 1 and 16 both recite the feature of "preparing a notification request according to an open network protocol". Quinn, however, fails to disclose or suggest that the data signal 30, which is generated and forwarded by the forwarding software 28, is prepared according to an open network protocol. Furthermore, the Examiner's remarks (made with respect to claims 8 and 9) that "inherently, transmitting and receiving emails one must use an open network protocol such as SMTP" do not have any bearing on the recited feature of "preparing a notification

request according to an open network protocol" since an e-mail message is not the same as a notification request. For example, a notification sent to a subscriber in response to a notification request notifies the subscriber of the occurrence of an event and can include only a fraction of the original message (*e.g.*, its subject), information which was not part of the original message (*e.g.*, the number of messages currently in the subscriber's mailbox), and indeed can be based on a non-messaging event (*see, e.g.*, claim 5). The notification request of Quinn, apparently relied on by the Examiner, is the data signal 30, which is forwarded to the mail notification server 40 (*see, e.g.*, Fig. 1 of Quinn), and Quinn fails to disclose or suggest that this data signal 30 is prepared according to an open network protocol. For at least this exemplary deficiency, Quinn fails to anticipate claims 1 and 16.

B. Claim 26

Applicants amend claim 26 to clarify that "a notification mechanism for notifying the subscriber is determined independently of the manner in which the requesting user provides the message". Applicants respectfully submit that these amendments are not intended to narrow the scope of the original claim, but are rather for precision of language and to explicitly recite within the claim what was believed to have already been implicitly defined therein. Accordingly, these amendments do not foreclose application of reasonable equivalents.

Claim 26 recites, *inter alia*, the feature of "requesting a notification of the subscriber by the requesting user". Quinn describes the automatic notification of receipt of an e-mail via a telephone system without requiring log-on to the e-mail server (*see, e.g.*, Abstract of Quinn). A

user doesn't request notification of a subscriber in Quinn. Indeed, a user may not even realize that by sending an e-mail, its recipient will receive a notification. Quinn describes a requesting user sending an e-mail to a recipient user, whereby the automatic e-mail notification system 10 of Quinn proceeds to automatically handle notifying the recipient user of the received e-mail (*see, e.g.*, col. 5, line 14 to col. 6, line 16 of Quinn). Thus, Quinn fails to disclose or suggest that a requesting user can request a notification of the subscriber.

Furthermore, claim 26 recites the feature of "wherein a notification mechanism for notifying the subscriber is determined independently of the manner in which the requesting user provides the message". Quinn is expressly directed to an automatic e-mail notification system (*see* claims 1-10 of Quinn). Indeed, the notification that occurs in Quinn is always predicated on receipt of an e-mail message (*Id.*). Thus, Quinn fails to disclose or suggest determining a notification mechanism for notifying the subscriber independently of the manner in which the requesting user provides the message (*e.g.*, via facsimile).

Even further, claim 26 recites the feature of "selecting said notification mechanism for notifying the subscriber by said notification server". Quinn discloses various embodiments of an automatic e-mail notification system, but Quinn fails to disclose or suggest selecting a notification mechanism (*e.g.*, via SMS). In Quinn, the notification mechanism is predetermined and static (*see* claims 1-10 of Quinn). Consequently, it follows that Quinn also fails to disclose or suggest the feature of "sending said notification to the subscriber through said [selected] notification mechanism by said notification server".

For at least these exemplary reasons, Quinn fails to anticipate claim 26.

C. Claims 2-4, 6, 8-15, 17-19, 22-25, and 27

Claims 2-4, 6, 8-15, 17-19, and 22-25 are not anticipated by Quinn at least by virtue of their dependency.

D. Claim 30

Claim 30 is canceled.

III. Claim Rejections -- 35 U.S.C. § 103(a)

Claims 5, 7, 20-21, and 28-29 stand rejected under § 103(a) as allegedly being unpatentable over Quinn in view of Shaffer. However, Shaffer fails to cure the deficiencies of Quinn discussed above. Indeed, while Shaffer discusses an event notification protocol, Shaffer fails to teach or suggest that the protocol is an "open network protocol". Shaffer describes a data filter 16 receives information from a variety of information sources (*see* col. 6, lines 13-22 of Shaffer), but Shaffer fails to disclose or suggest "preparing a notification request according to an open network protocol" based on an event detected by the data filter from an information source.

Furthermore, Shaffer fails to teach or suggest allowing a requesting user to directly request a notification of a subscriber, selecting the notification mechanism for notifying the subscriber (by the notification server), determining independently of the manner in which the requesting user provides the message a notification mechanism for notifying the subscriber, and sending the notification to the subscriber through the selected notification mechanism (by the

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/475,147
Attorney Docket No. Q58584

notification server). Thus, claims 5, 7, 20-21, and 28-29 are patentable over Quinn and Shaffer at least by virtue of their dependency.

IV. New Claims 31-37

Applicants add new claims 31-37, which recite disclosed, but previously unclaimed, features. Claims 31-37 are patentable at least by virtue of their dependency.

V. Formal Matters

A. Priority

Applicants thank the Examiner for acknowledging Applicants' claim for priority under 35 U.S.C. § 119(e).

B. Information Disclosure Statement

Applicants thank the Examiner for providing a signed and initialed copy of the Form PTO-1449 submitted with the IDS filed on July 3, 2000, thereby indicating consideration of the references cited therein.

C. Claims

Applicants amend claims 1, 4, 6, 10-12, and 15 to make various cosmetic changes. Applicants respectfully submit that these amendment are not intended to narrow the scope of the original claims, but are rather for precision of language and to explicitly recite within the claim what was believed to have already been implicitly defined therein.

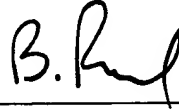
AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/475,147
Attorney Docket No. Q58584

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Billy Carter Raulerson
Registration No. 52,156

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Date: February 4, 2003

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 30 is canceled.

The claims are amended as follows:

1. (Amended) A system for notifying a subscriber upon an occurrence of an event,
the system comprising:
 - (a)——an event-generating system for generating the event;
 - (b)——a notification request sender for detecting the occurrence of the event and for
preparing a notification request according to an open network protocol; and
 - (c)——a notification server for receiving said notification request from said notification
request sender, and for notifying the subscriber of the occurrence of the event,
wherein said notification server is not in direct communication with said event generating
system.
4. (Amended) The system of claim 2, wherein said messaging system further
comprises: ~~(i)~~ an API (application programming interface) for providing an interface for
detecting the event by said notification request sender.

6. (Amended) The system of claim 1, wherein said notification server further comprises:

(i)——an open network protocol server for receiving said notification request from said notification request sender; and

(ii)——a notification messaging server for receiving said notification request from said open network protocol server and for notifying the subscriber of the event according to said notification request.

10. (Amended) The system of claim 9, wherein said notification request sender further comprises:

(i)——a notification event detector for detecting the event; and

(ii)——a notification protocol adapter for preparing and transmitting said notification request.

11. (Amended) The system of claim 10, wherein said notification server further comprises: ~~(iii)——~~ a notification server protocol adapter for receiving said notification request and for determining validity of said notification request, such that if said notification request is valid, said notification server protocol adapter passes information from said notification request to said notification messaging server.

12. (Amended) The system of claim 1, further comprising: ~~(d)~~ a network for connecting said notification request sender to said notification server.

15. (Amended) The system of claim 13, wherein said event-generating system further comprises:

- (i) — an internal messaging system for generating a message event; and
- (ii) — a notification request sender for sending said notification request to said notification server.

26. (Amended) A method for sending a message to a subscriber by a requesting user, the method comprising:

- (a) providing a notification server;
- (b) requesting a notification of the subscriber by the requesting user, wherein a notification mechanism for notifying the subscriber is determined independently of the manner in which the requesting user provides the message ~~the requesting user does not select a notification mechanism for notifying the subscriber;~~
- (c) sending said notification to said notification server;
- (d) selecting said notification mechanism for notifying the subscriber by said notification server; and

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/475,147
Attorney Docket No. Q58584

(e) sending said notification to the subscriber through said notification mechanism by said notification server.

Claims 31-37 are added as new claims.